



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,551	02/09/2001	Thomas G. Woolston	032997-028	9095

7590 08/19/2002

Richard J. McGrath
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

THOMPSON JR, FOREST

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 08/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,551

Applicant(s)

WOOLSTON, THOMAS G.

Examiner

Forest O. Thompson Jr.

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/09/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 11-50 have been examined.
2. This application is a division of U.S. patent application #09/253,057, filed on 02/19/1999, now U.S. patent #6,266,651., which is a continuation of U.S. patent application #09/166,779, filed on 10/06/1998, which is a division of patent application #08/554,704, filed on 11/07/1995, now patent #5,845,265, which is a continuation in part of patent application #08/427,820, filed on 04/26/1995. Applicant claims priority to patent application #08/427,820. Examiner accepts the priority claim of applicant to patent application #09/166,779, but requires applicant to particularly point out and cross reference those sections of application #08/427,820 to the claims of the present application that disclose these claims, to support his claim for priority.

Drawings

3. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3625

5. Claims 17 and 41 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim language states "wherein the electronic transactional system is implemented on a computer system that also hosts an electronic auction system." Correction is required.

6. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 27 states "and the second transactional tier electronic." in line 9. Examiner cannot determine the language of the claimed feature with certainty. For examination purposes, examiner has assumed that the applicant's intent was to claim "and the second transactional tier." Correction is required.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 3625

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,266,651. Although the conflicting claims are not identical, they are not patentably distinct from each other, because they claim the same subject matter, even though one claims an auction and the other claims commercial transactions.

The subject matter claimed in claims 11, 27, 36, and 46 of the instant application is fully disclosed by claims 1, 26, and 45 of the patent. The only difference between the claims is: the patent discloses a computer-implemented two-tiered electronic auction system, while the application discloses a computer-implemented electronic transactional system comprising the same features as the patent. Examiner considers the two systems as equivalent systems for purposes of examination since the computer-implemented two-tiered electronic auction system is a computer-implemented electronic transactional system that discloses the claimed aspects of the computer-implemented electronic transactional system. Therefore, the patent and the instant application are considered equivalent.

Response to Arguments

8. Applicant's arguments with respect to claims 11-50 have been considered but are moot in view of the new ground(s) of rejection.

Status of Claims

9. Claims 11-50 would be allowable pending the filing of a proper and timely terminal disclaimer and pending correction of the 35 USC § 112 rejection. The instant invention relates to a novel and unobvious system and method for a computer-implemented electronic transactional system. The allowable subject matter is:
- a) (as per independent claims 11, 36) a data repository storing information corresponding to an inventory of one or more available items;
 - b) (as per independent claims 11, 27, 36) a first tier providing a first participant access to the inventory of one or more items in the data repository, the inventory being offered to the first participant under a first pricing scheme;
 - c) (as per independent claims 11, 27, 36) a second tier providing a second participant, different from the first participant, access to the inventory of one or more items in the data repository being offered to the second participant under a second pricing scheme different from the first pricing scheme;
 - d) (as per independent claims 11, 27, 36) differentiating first participants from second participants;
 - e) (as per dependent claim 46, depending from claim 36) presenting for auction an item description stored in a database operationally coupled to the electronic auction system.

Conclusion

Art Unit: 3625


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest O. Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


F. Thompson

August 5, 2002


JEFFREY A. SMITH
PRIMARY EXAMINER